

Application of: Ruff, Kenneth J.
Serial No.: 10/065,857
Response to Restriction Requirement

REMARKS

The Examiner has required an election of Species. It is submitted that the restriction requirement is in error. However, the Applicant provisionally elects Species B as set forth by the Examiner.

It is submitted that the restriction requirement is in error. No finding or even allegation of the Species being distinct has been made as required by MPFP 809. Species of an invention are not determined by what is shown in the drawings but rather by what is defined in the claims. The restriction requirements should have been set forth in terms of the claims and not the various figures. Therefore, it is respectfully requested that the restriction requirement be withdrawn and presented in proper format. It is alleged by the Patent Office that only Claims 1 and 26 are generic; however, it is submitted that this is in error too in that many other of the Claims are also generic or linking.

The basic invention is the use of existing ceramic clay components to make a bird accessory which can take two forms, either a birdhouse and/or bird feeder. The structure shown in the alleged Species A is a bird feeder. The structure shown in Species E is also a bird feeder. The structures shown in FIGS. 6 through 15 are basically a birdhouse. The common feature to all Species which is addressed in at least Claims 1 - 3 and 26, is the use of a top ceramic clay component and a receptacle ceramic clay component. The remainder of the claims add details some of which are directed to a birdhouse and some of which are directed to a bird feeder. Claims 4 - 8 are submitted to cover Species B - E, Claim 9 can be applied to all Species A through E and Claim 10 can be read on Species B through E, Claim 11 could be read on Species

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A through E, assuming an additional component is added to the structure shown in Species A.

Claim 12 is directed to the Species B - D, Claim 13 is directed to the Species shown in Figure A, Claim 14 is directed to Species B, Claims 15 - 20 are directed to Species B - D, Claims 21 through 26 are directed to Species A through E.

It is encumbered upon and the duty of the Patent Office to properly structure a restriction requirement. See In re Sang Su Lee, 61 U.S.P.Q. 2d1430 (Fed. Cir. 2002). It is not proper to divide an invention by what is shown in the Figures but only by what is contained in the claims and by reading the specification and then reviewing what the figures show. It is again submitted that the restriction requirement is in error. It is further submitted that the Invention is not five Species of invention but rather, at best, two, a bird feeder and a birdhouse, both of which however, have common elements. Each Claim defines a different invention and not necessarily a Species of invention. Because there are several generic claims, and not just the alleged generic Claims 1 and 26 for this reason alone, it is submitted that the restriction requirement is in error and should be reconsidered and withdrawn. It is also inappropriate to compel an applicant to discuss potential or possible patentable distinctions between the claims in the absence of relevant prior art.

Given the foregoing, it is respectfully requested that the restriction requirement be reconsidered and withdrawn.

Reconsideration and withdrawal of the requirement for restriction are respectfully requested. The Applicant contends that the Species claims are closely related and have a

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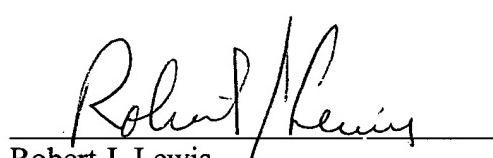
common utility. The Applicant further contends that the Species claims don't pose a serious burden for the examiner by requiring separate searches.

Because Applicant may wish to pursue claims of the non-elected Species at a later date by Divisional Application, if necessary, it is requested that these claims, pursuant to 37 CFR 1.142, be permitted to remain in the application.

If any issue regarding the allowability of any of the pending claims in the present application could be readily resolved, or if other action could be taken to further advance this application such as an Examiner's amendment, or if the Examiner should have any questions regarding the present amendment, it is respectfully requested that the Examiner please telephone Applicant's undersigned attorney in this regard.

Respectfully submitted,

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